

**Remarks.**

Claims 1, 17, 31 and 39 have been amended to remove the non-statutory rejections of such claims by the Examiner. The preface to such claims was revised by replacing the phrase “for assisting in the management of a service provider” with the phrase “providing transactional service information to a service provider.”

The amendment to limitations (a) and (b) of the independent claims add limitations that are not taught or disclosed in the prior art, the evaluation processor receiving evaluation data from a plurality of service providers, and the providing by the service evaluator of the unique transaction record by the service provider. Such amendments are supported in the specification at page 4, line 28; page 5, line 29; page 6, lines 15-16; page 8, line 4; page 9, line 13; and page 10, line 15.

Claim 39 has been amended to remove the vagueness objection and to add a limitation not taught in the prior, but supported in the specification.

A majority of the claims have been amended to remove the objections to the claims as being passive and/or wordy,

**Response to Claims Rejections.**

**Rejection of Claims 1-3, 5-16, 17-18, 20-30, 31-38, 39-53 under 35 U.S.C. §101.**

Rejection of claims 1, 17, 31 and 39 is respectfully traversed to the extent such rejection applies to newly amended claims. Claims 1, 17, 31 and 39 have been amended to delete the objection that the steps of the method of the invention were merely an abstract idea. Amended claims 1, 17, 31 and 39 now provide that the invention is directed toward “A method for providing transaction service information to a service provider.”

**Rejection of Claims 39-53 under 35 USC § 112.**

Rejection of claim 39 is respectfully traversed to the extent such rejection applies to the newly amended independent claim 39 by deleting the word “may,” as suggested by the Examiner, so that the phrase is no longer indefinite.

**Rejection of claims 1-3, 6-11, 13-16, 17-18, 20-25, 27-30, 31-33, 35-38, 39-48, 50-52 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over KESEL (US Patent 6,026,387).**

**Analysis of U.S. Patent No. 6,026,387 to Kesel**

Kesel discloses a system for the receipt of oral comments from a customer/user. In Kesel, the service provider is the retail store. The system is located in the facility of the service provider and the customer/user may submit various comments to the menu-driven system. The customer does not enter any information regarding the service provider since the system is on site. The customer does not enter any unique transaction identifier. The system only assigns a date/time identifier. Oral comments are analyzed on the basis of

selected descriptors and reports are generated on correlated subjects, including employees. Kesel does not disclose a system capable of receiving evaluation data from customers at a plurality of service providers. Kesel does not disclose a system whereby the service provider provides a unique transaction record to the analyzer/evaluation processor. Kesel does not disclose a system whereby the service provider provides to the analyzer/evaluation processor a unique identifier of the employee. Kesel does not disclose a system whereby the service provider provides to the analyzer/evaluation processor selected service provider information. Kesel does not disclose a system whereby the service provider receives comments from the employee regarding the services provided by the service provider.

**Rejection of claims 1, 17, 31 and 39 under 35 U.S.C. §102(b) as anticipated by Kesel.**

Applicant respectfully traverses the rejection of claims 1, 17, 31 and 39 under 35 U.S.C. §102(b) as anticipated by Kesel to the extent such rejection applies to newly amended claims 1, 17, 31 and 39.

Anticipation under §102(b) requires the disclosure in a single prior art reference of each element of the claim under consideration. *Soundscriber Corp. v. U.S.*, 175 Ct. Cl. 644, 360 F.2d 954, 960, 148 USPQ 298, 301, adopted, 149 USPQ 640 (Ct. Cl. 1966). For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1488; (CAFC, 1997); See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ("[T]he [prior art] reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. An expert's conclusory testimony, unsupported by the documentary evidence, cannot supplant the requirement of anticipatory disclosure in the prior art reference itself. See *Jamesbury Corp. v. Litton Indus. Prods., Inc.*, 756 F.2d 1556, 1563, 225 USPQ 253, 257-58 (Fed. Cir. 1985). Kesel describes only a customer feedback system. Such feature cannot be inherent in Kesel as there is nothing in Kesel to suggest such a feature. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. at 1269, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

Firstly, Applicant has amended the independent claims to include the limitation that the instant invention receives evaluation data from a plurality of service providers. This limitation is not taught in Kesel.

Secondly, Kesel does not disclose that the valuation data contains a unique identifier of the service provider. However, the Examiner asserts

“As for claims 1, 17, 31, KESEL discloses a method for assisting in the management of a service provider having at least one manager, at least one employee and at least one service evaluator, the method comprising the steps of: (a) service evaluator contacting an evaluation processor and providing evaluation data to the processor, (b) the valuation data containing a unique identifier of the service provider, and (c ) the processor provides correlated information from the evaluation data to the service provider manager.”

Applicant respectfully traverses the assertion that the valuation data contains a unique identifier of the service provider. The Applicant believes that the Examiner has equated the service provider as being the employee. Such is not the case. The service provider as defined in the specification of the instant invention is the business enterprise (see Specification, page 3, line 17). The system of Kesel is an in-house system. There is no need in Kesel to provide a unique service provider identification. None of the descriptors identified by Kesel contain a unique store identifier. The system of Kesel handles only one service provider. The references to Kesel that the Examiner has provided to exemplify the scope of Kesel are inapt. For example, references to col. 2, lines 1-15 (or 2:1-15), 2:25-30 are all references to a portion of the Background of the Invention wherein Kesel describes the prior art of the customer obtaining and filling out comment cards at the retailer/service provider site. At 3:1-20, Background of the Invention, is described the filling out of comment cards at the Customer Service Desk at the retailer/service provider site. Such features are not a part of the system of Kesel.

At 4:43-67, Summary of the Invention, the system is described as being located at provider site. All references of Kesel to prior art processes are those employed at the site of the service provider, and therefore, the unique service provider identifier are not necessary.

At 5:50-67, Kesel describes the assigning of a unique customer identifier, which is then entered into the system at the time that the customer purchases a product. Kesel does not describe the providing of any service provider information.

Therefore, Kesel cannot anticipate the independent claims of the instant invention since Kesel does not disclose, either expressly or inherently, all of the limitations of such claims, specifically, Kesel does not disclose a system the evaluation processor receives evaluation from a plurality of service providers. Kesel does not disclose a system whereby the service provider provides a unique identifier. Both of such limitations are part of newly amended claims 1, 17 and 31.

Further, Kesel does not describe or disclose a system wherein the comments regarding the goods or services are provided by the employee, which limitation is a part of newly amended claim 39. Therefore, Applicant considers claims 1, 17, 31 and 39 to be in condition for allowance.

**Rejection of claims 2-3, 6-11, 13-16, 18, 20-25, 27-30, 32-33, 35-38, 40-48, 50-52 under 35 U.S.C. §102(b) as anticipated by Kesel.**

Claims 2-3, 6-11, and 13-16 are dependent on newly amended claim 1. Claims 18, 20-25, and 27-30 are dependent on newly amended claim 17. Claims 32-33 and 35-38 are

dependent on newly amended claim 31, and claims 40-48 and 50-52 are dependent on newly amended claim 39. Applicant considers all such claims to be allowable on their own merits and not anticipated by Kesel. However, since newly amended independent claims 1, 17, 31 and 39 are not anticipated by Kesel, their dependent claims cannot be considered to be anticipated by Kesel, and such dependent claims are now deemed by Applicant to be allowable.

**Rejection of claims 1, 17, 31 and 39 under 35 U.S.C. §103 as obvious over Kesel.**

Rejection of claims 1, 17, 31 and 39 under 35 U.S.C. §103 as obvious over Kesel is respectfully rejected to the extent that such rejection applies to newly amended claims 1, 17, 31 and 39.

The PTO has the burden under section 103 to establish a prima facie case of obviousness. See In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984); see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In order to find claim 1 to be obvious, the Examiner must show that there must have been something present in those teachings to suggest to one skilled in the art that the claimed invention was obvious, as stated in In re Bergel, 48 C.C.P.A. 1102, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (CCPA 1961); In re Sponnoble, 56 C.C.P.A. 823, 405 F.2d 578, 585, 160 USPQ 237, 244 (CCPA 1969). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (quoting Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)).

As stated above, the system of Kesel is an in-house system. The system services but one location. The system of Kesel is located at the service provider site. Kesel does not disclose the receipt of valuation date from service providers at other locations. Kesel is absolutely silent on this point. Therefore, one of ordinary skill in the art would find no reason in Kesel to suggest that a system that receives evaluation data from a plurality of service providers is necessary or desirable. For the same reason, one of ordinary skill in the art would find no reason for the service provider to provide a unique identifier of the service provider. There is no teaching in Kesel that such features are either necessary or desirable.

Therefore, claims 1, 17, 31 and 39 cannot be found to be obvious over Kesel. To the extent that the Examiner asserts that there is some teaching in Kesel that a system that receives evaluation data from a plurality of service providers is necessary or desirable, then the Examiner is respectfully requested to provide reference in Kesel to such teaching. Similarly, if the Examiner asserts that there is some teaching in Kesel for the service provider to provide a unique service provider identification, then the Examiner is respectfully requested

to provide reference in Kesel to such teaching.

**Rejection of claims 2-3, 6-11, 13-16, 18, 20-25, 27-30, 32-33, 35-38, 40-48, 50-52 under 35 U.S.C. §103(a) as obvious over Kesel.**

Claims 2-3, 6-11, and 13-16 are dependent on newly amended claim 1. Claims 18, 20-25, and 27-30 are dependent on newly amended claim 17. Claims 32-33 and 35-38 are dependent on newly amended claim 31, and claims 40-48 and 50-52 are dependent on newly amended claim 39. Applicant considers all such claims to be allowable on their own merits and not obvious over Kesel. However, since newly amended independent claims 1, 17, 31 and 39 are not obvious over Kesel, their dependent claims cannot be considered to be obvious over Kesel, and such dependent claims are now deemed by Applicant to be allowable.

**Rejection of claims 12, 26, 34, 49 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kesel.**

The Examiner has rejected claims 12, 26, 34 and 49 as under 35 U.S.C. §103(a) as being unpatentable over Kesel. Claims 12, 26, 34, and 49 are dependent on newly amended independent claims 1, 17, 31 and 39 respectively, which independent claims have been deemed to be non-obvious and patentable over Kesel. Therefore the combinations of claims 1 and 12, 17 and 26, 31 and 34, and 39 and 49 cannot be found to be obvious, and Applicant now considers such claims to be in condition for allowance.

**Rejection of claims 2,12-16, 18, 26-30, 32, 34-38, 40, 49-53 under 35 U.S.C. 103(a) as being unpatentable over Kesel as applied to claims 1-3, 5-16, 18, 20-30, 31-38, 39-53 above, and further in view of Remler (US 2002/0077906) or Fuerst (US 6,189,029).**

Rejection of claims 1, 31 and 39 is respectfully traversed to the extent such rejection applies to the newly amended claims 1, 31 and 39. As demonstrated above, Kesel cannot anticipate or render claim 1 obvious. At stated by the Examiner, Remler is cited to teach interactive survey to improve services and products. Such teaching is not an element of newly amended claims 1, 31 and 39. Fuerst was cited to teach interactive survey to improve survey results speed and effectiveness. Such teaching is not an element of newly amended claims 1, 31 and 39. Neither Kesel, Remler nor Fuerst teach or suggest the use of a service evaluator to receive evaluation data from a plurality of service providers. Neither Kesel, Remler nor Fuerst teach or suggest the providing by the service provider of a unique identifier. Neither Kesel, Remler nor Fuerst teach or suggest the providing of service evaluation by an employee of the service provider. The combination of Kesel, Remler and/or Fuerst cannot result in the instant invention. Therefore, Applicant considers claims 1, 31 and 39 to be in condition for allowance. The Examiner did not list independent claim 17 in the above rejection, but Applicant assumes such omission to be inadvertent, and the same arguments against rejection of claims 1, 31 and 39 apply to claim 17.

**Rejection of claims 2-3, 5-16, 18, 20-30, 32-38, 40-53 under 35 U.S.C. 103 over Kesel, and further in view of Remler or Fuerst.**

Claims 2-3, and 5-16 are dependent on newly amended claim 1. Claims 18, 20-30 are dependent on newly amended claim 17. Claims 32-38 are dependent on newly amended claim 31, and claims 40-53 are dependent on newly amended claim 39. Applicant considers all such claims to be allowable on their own merits and not obvious over Kesel in view of Remler or Fuerst. However, since newly amended independent claims 1, 17, 31 and 39 are not obvious over Kesel in view of Remler or Fuerst, their dependent claims cannot be considered to be obvious over Kesel, and such dependent claims are now deemed by Applicant to be allowable.

**Conclusion.**

Claims 1-3, 5-16, 17-18, 20-30, 31-38, 39-53 have been amended to remove the rejection under 35 U.S.C. §101 by removing the non-statutory subject matter and the indefiniteness under §112.

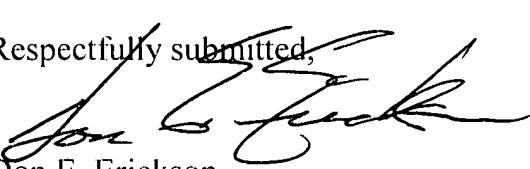
Claims 2, 8, 14-16, 18, 23, 28-30, 32, 36-38, 40, 45 and 51-53 have been amended to make the claims active, and more concise.

Applicant has amended independent claims 1, 17, 31, and 39 to avoid the rejections based under 35 U.S.C. §§102(a) and 103. All of such amendments are supported in the specification. Applicant has shown that the Kesel does not disclose or teach the critical limitations of the currently amended independent claims in that Kesel does not disclose or teach a system whereby evaluation data may be received from a plurality of service providers. Nor does Kesel disclose or teach a system whereby the service provider provide a transaction record that includes a unique identifier of the service provider. Neither Remler nor Fuerst are pertinent independent claims 1, 17, 31 or 39. All of the dependent claims rely on newly amended independent claims that are not anticipated or rendered obvious by Kesel, and such dependent therefore cannot be anticipated or rendered obvious by Kesel.

Applicant believes that all pending claims of the application are in condition for allowance. Reconsideration and allowance of the claims is respectfully requested.

In view of the extensive amendments to the claims, the Applicant has included a clean copy of all claims.

Respectfully submitted,

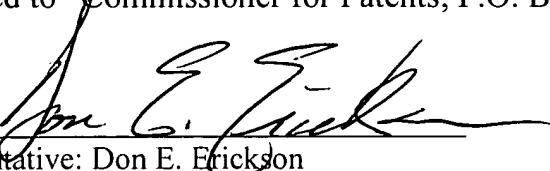
  
Don E. Erickson  
Law Offices  
7668 El Camino Real, Ste. 104 #627  
Carlsbad, CA 92009  
(760) 918-0520

Dated: April 6, 2004

**Certificate of Service**

I hereby certify that this **Amendment and Response** is being deposited with the United States Postal Service, first class mail, postage prepaid on the date indicated above and is addressed to "Commissioner for Patents; P.O. Box 1450; Alexandria, VA 22313-1450."

Signed:



Representative: Don E. Erickson

Date of Signature: April 6, 2004